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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,875	12/29/2003	David Horsley	ONX-113/DIV	2815
27652	7590	01/11/2005	EXAMINER	
JOSHUA D. ISENBERG 204 CASTRO LANE FREMONT, CA 94539			WILLIAMS, HOWARD L	
			ART UNIT	PAPER NUMBER
			2819	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/747,875

**Applicant(s)**

HORSLEY ET AL.

**Examiner**

Howard L. Williams

**Art Unit**

2819

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 070904.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 10/012,688, filed 30 October 2001." should be entered following the title of the invention or in the first paragraph of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 and 14-16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 6,674,383. This is a double patenting rejection.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 lacks antecedent basis for the phrase "the PWM signal."

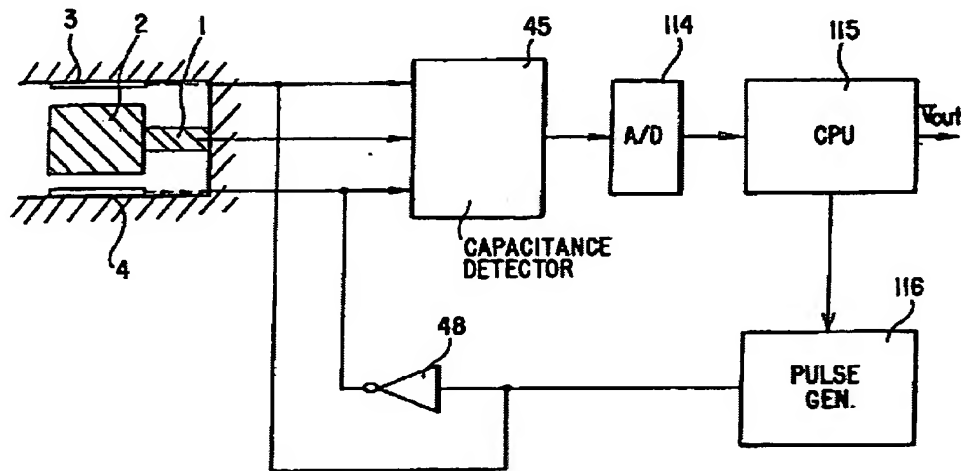
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by Suzuki et al. (US 5,095,750). Suzuki et al. discloses a MEMs or electrostatic sensor/actuator which operates using pulse width modulation (PWM 47 cover) functioning in a servo loop. In figure 24

**FIG. 24**




Suzuki shows the MEMs device (1-4), capacitance detection 45 shown in figure 21 to include an integrator, an analog-to-digital converter 114 and processor 115 for digital calculation of the desired duty cycle and pulse width modulation circuit 116. In column 9, lines 40-49 and again in column 12, lines 18-22 Suzuki et al. discloses that the frequency of the PWM signal should be greater than the natural frequency of the cantilevered movable electrode.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Loeb et al. (US 6,829,131 B1) discloses PWM actuated MEMs loudspeaker which includes a PWM generator, MEMS device, sense amplifier, ADC and DSP in a loop. US 6,373,682 B2 to Goodwin-Johanssen discloses a MEMs based electrostatically variable capacitor (see fig. 9; col. 11 line 39+). US 6082196 A to Nanoyama et al. discloses a MEMS system using PWM. MacIntosh (US 2001/0047689 A1) recognizes equivalent operation of a compliant actuator and a capacitive accelerometers being returned to the equilibrium position (¶10006) and also discusses having a pulse source to apply bias to the capacitive bridge (fig. 8).

Any inquiry concerning this communication should be directed to Howard L. Williams at telephone number 571.272.1815. The Patent and Trademark Office has a new central facsimile number for application specific correspondence intended for entry, it is 703-872-9306.

1/5/05  
Voice 571.272.1815

  
Howard L. Williams  
Primary Examiner  
Art Unit 2819